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10/826,165

04/16/2004

Jiro Kanie

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25191 7590 10/07/2009
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EXAMINER

YOUNG, MICAH PAUL

ART UNIT

PAPER NUMBER

1618

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIRO KANIE

Application No. 10/826,165
Technology Center 1600

Mailed: October 7, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on October 5, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated March 16, 2009. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter” appearing on pages 6-8 of the Appeal Brief filed March 16, 2009 is deficient because it does not map independent claim 11 to the specification. Correction is required.

Section 1205.03 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 7, July 2008) states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in

dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

EXAMINER'S ANSWER, MISSING REFERENCE

It is noted that a copy of the Kabushiki et al. article (Total Parenteral Nutritional and Enteral Nutrition, pp. 283-307, Suppl. 5, *Nippon Rinsho*, vol. 59, no. 782) appears to be missing from the Image File Wrapper (IFW). This reference was listed on page 2 of the Examiner's Answer mailed June 24, 2009 under "Evidence Relied Upon" and cited in the § 103(a) rejection of claims 8-13 as being unpatentable over the combined disclosures of Resmer et al. (USPN 5,232,733) in view of Kabushiki et al. Appropriate correction is required. If the article is not in English, a full certified English translation must be obtained.¹

¹ Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: . . . (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection" (emphasis added).

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed March 16, 2009 defective, as required by 37 CFR § 41.37(d);
- 2) to notify the Appellant to submit a “paper” which corrects the Appeal Brief’s “Summary of Claimed Subject Matter” under 37 CFR §41.37(c)(1)(v);
- 3) to acknowledge and consider any “paper” submitted by Appellant to correct the Appeal Brief;
- 4) to locate a copy of the Kabushiki et al. article;
If it is in English:
 - a) have a complete copy scanned into the IFW and, if appropriate, furnish a copy to appellant;If it is not in English:
 - a) to obtain a full certified English language translation of the Kabushiki article;
 - b) to complete the IFW by having the translation obtained scanned into the IFW file; and
 - c) to provide a copy of the translation obtained to Appellant; and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

psb

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